

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 37, 40-44, 48, 50, 51, 53, and 73-74 are pending in the present application, Claims 48 and 50 having been withdrawn, Claims 37 and 40 having been amended, and Claims 73-74 having been added. Support for the present amendment is found, for example, at Fig. 2 and Claim 39. No new matter is added.

In the outstanding Office Action, Claims 37, 39-44, 51, and 52 were rejected under 35 U.S.C. §103(a) as unpatentable over Huang et al. (U.S. Patent Publication No. 2006/0024732, hereinafter Huang) in view of Colin et al. (U.S. Patent No. 5,925,573, hereinafter Colin).

Applicants respectfully submit that amended Claim 37 patentably distinguishes over a proper combination of Huang and Colin for at least the reasons stated below. Claim 37 recites, *inter alia*, “forming an initial residue at the bottom of the first receptacle.” A proper combination of Huang and Colin do not disclose this feature.

The Advisory Action mailed November 26, 2010 states “these microdiscs *may* still form a residue upon a bottom” (emphasis added). There is no teaching of actually forming a residue in Huang. This statement from the Advisory Action amounts to unsupported speculation, which may not be used in support of a rejection. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”). “When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”¹ In *In re Mills*, 16 USPQ2d 1430 (Fed. Cir.

¹ *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

1990), the Federal Circuit reversed the decision of the PTO Board which opined that it was sufficient if a prior art reference was merely “capable of” being operated according to the functional language of the claim at issue.

Moreover, Huang states “rotating said microdevices within said microchannels by a magnetic force, whereby the combined effect of said magnetic force and said preferential axis of magnetization of said microdevices substantially separates said microdevices from each other.”² Paragraph [0011] of Huang describes microchannels sufficiently narrow to prevent the microdiscs from forming a chain. This means that the magnetic field of Huang separates the microdevices from each other.

Moreover, amended Claim 37 recites “wherein the transporting uses relative displacement of a magnetic field created by a second magnetic mechanism.” Paragraph [0144] of Huang refers to magnet that draws the microdiscs into a channel. However, Huang does not disclose a “first magnetic mechanism” and a “second magnetic mechanism” as recited in Claim 37.

Furthermore, Colin does not cure the deficiencies in Huang. Colin describes a method that uses a magnetic field for agglomeration and displacement of metal complexes which are the result of the incubation of a liquid sample with a reactant including metal particles. In the embodiment shown in Colin’s Fig. 3, there is a well 15 for receiving a sample. At this stage, the magnetic reagent is not added. The magnetic reagent is added at incubation wells 16.³ Thus, the first well is only adapted to receive the liquid sample. The fluid division is made upstream with respect to well 15. The magnetic elements 3 in Colin are used to transfer the intermediate complexes in second wells 16a-16j towards reading wells 17.⁴ There is no disclosure that magnetic elements 3 are used to attract the magnetic

² See, Huang, paragraphs [0012], [0013], and claim 59.

³ Colin, col. 3, lines 36-43, and col. 10, lines 15-20.

⁴ Colin, col. 10, lines 20-30.

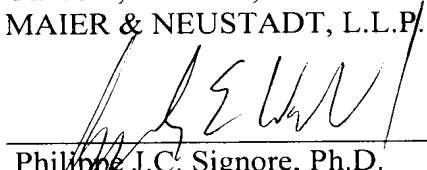
particles fixed to the analyte to a bottom of the first receptacle and to form an initial residue at the bottom of the first receptacle. Thus, Colin does not disclose the above-noted element of Claim 1.

In view of the above-noted distinctions, Applicants respectfully submit that Claim 37 (and any claims dependent thereon) patentably distinguish over a proper combination of Huang and Colin.

Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Philippe J.C. Signore, Ph.D.
Attorney of Record
Registration No. 43,922

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Joseph E. Wrkich
Registration No. 53,796